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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,994	11/25/2003	Martin Newman	0EKM-108414	7981
30764	7590	01/25/2006	EXAMINER	
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP			CHAMBERS, MICHAEL S	
333 SOUTH HOPE STREET			ART UNIT	
48TH FLOOR			PAPER NUMBER	
LOS ANGELES, CA 90071-1448			3711	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/723,994

Applicant(s)

NEWMAN ET AL.

Examiner

Mike Chambers

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 20-25 and 27-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 20-25 and 27-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 20-25, and 27-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swift (0722927). Swift discloses the elements of claim 1,

a forward striking face; and a rearward surface, opposite the forward striking face; wherein the forward striking face is configured to include an engineered texture having a substantially planar recessed surface and a prescribed, regular pattern of discrete geometric shapes projecting forward from the recessed surface, wherein the geometric shapes are spaced apart from each other along the recessed surface by at least 0.1 mm and each geometric shape is solid and has a volume of less than 0.0007 mm³ (fig 1). The specification provides no unexpected or surprising results in using the dimensions cited, therefore these limitations are considered design choices. It would have been obvious to one of ordinary skill in the art to have selected an appropriate dimension for the grooves, planar surfaces, and volume of the geometric shape based on manufacturing and marketing decisions.

As to claims 2-5 : Swift discloses a pattern of geometric shapes (fig 1). The specification provides no unexpected or surprising results in using the dimensions cited, therefore these limitations are considered design choices. It would have been obvious to

one of ordinary skill in the art to have selected an appropriate dimension for the grooves, planar surfaces, and volume of the geometric shape based on manufacturing and marketing decisions.

As to claim 6 : Swift discloses same sized geometric shapes (fig 1).

As to claim 7 : Swift discloses a plurality of grooves (fig 1).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swift as applied to claim 1 above, and further in view of Official Notice taken in the prior office action . Official Notice was taken that it is well known in the art to use welding to attach the members. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent attachment means based on cost and design considerations. Official notice is also taken that the use of metal clubs is well known in the art and it would be obvious to utilize a metal head in order to present the consumer with a typical head.

As to claim 21 : Swift discloses an integral front and sole portion (fig 1,4).

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swift as applied to claim1 above, and further in view of Official Notice. Official Notice was taken in the prior office action that the loft angles cited are well known in the art. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent lofts based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 25 : Swift discloses a first plurality of shapes (top row) and a second plurality of shapes (2nd row) that are adjacent (fig 1).

As to claim 27 : Swift discloses geometric shapes (fig 1). The specification provides no unexpected results in having more than one orientation. It would have been obvious to one of ordinary skill in the art to have selected an appropriate design and orientation based on cost and design considerations and to increase the player satisfaction with the device.

As to claims 29-39: See claim 1-4, 6,7,20-25, 27 and 28 rejections. These claims are merely slight variations of the previous claims and represent the same invention.

Also,

Claims 1-7,20-25, and 27-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (0749174). Davis discloses the elements of claim 1,

a forward striking face; and a rearward surface, opposite the forward striking face; wherein the forward striking face is configured to include an engineered texture having a substantially planer recessed surface and a prescribed, regular pattern of discrete geometric shapes projecting forward from the recessed surface, wherein the geometric shapes are spaced apart from each other along the recessed surface by at least 0.1 mm and each geometric shape is solid and has a volume of less than 0.0007 mm³ (fig 1). The specification provides no unexpected or surprising results in using the dimensions cited, therefore these limitations are considered design choices. It would have been obvious to one of ordinary skill in the art to have selected an appropriate dimension for the grooves, planar surfaces, and volume of the geometric shape based on manufacturing and marketing decisions.

As to claims 2-5 : Davis discloses a pattern of geometric shapes (fig 1). The specification provides no unexpected or surprising results in using the dimensions cited;

therefore these limitations are considered design choices. It would have been obvious to one of ordinary skill in the art to have selected an appropriate dimension for the grooves, planar surfaces, and volume of the geometric shape based on manufacturing and marketing decisions.

As to claim 6 : Davis discloses same sized geometric shapes (fig 1,2).

As to claim 7 : Davis discloses a plurality of grooves (fig 1,2).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis as applied to claim 1 above, and further in view of Official Notice taken in the prior office action . Official Notice was taken that it is well known in the art to use welding to attach the members. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent attachment means based on cost and design considerations. Official notice is also taken that the use of metal clubs is well known in the art and it would be obvious to utilize a metal head in order to present the consumer with a typical head.

As to claim 21 : Davis discloses an integral front and sole portion (fig 1,2).

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis as applied to claim 1 above, and further in view of Official Notice. Official Notice was taken in the prior office action that the loft angles cited are well known in the art. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent lofts based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 25 : Davis discloses a first plurality of shapes (top row) and a second plurality of shapes (2nd row) that are adjacent (fig 1).

As to claim 27 : Davis discloses geometric shapes (fig 1). The specification provides no unexpected results in having more than one orientation. It would have been obvious to one of ordinary skill in the art to have selected an appropriate design and orientation based on cost and design considerations and to increase the player satisfaction with the device.

As to claims 29-39: See claim 1-4, 6,7,20-25, 27 and 28 rejections. These claims are merely slight variations of the previous claims and represent the same invention.

Response to Arguments

Applicant's arguments with respect to claims 1-7,20-25, and 27-39 have been considered but are moot in view of the new ground(s) of rejection.

With regards to the telephone interview on 12/16/05: There is an old proverb that talks about the spoken word belonging half to the speaker and half to the listener. The examiner regrets any miscommunication that may have been transmitted. It was the examiner's intent to convey that the more structure that is found in the claim language, the better the chance of avoiding the cited art. It was not the examiner's intent to convey the idea that criticality of a design feature is not needed. Otherwise one could avoid cited art by merely writing claim language that would substitute a screw attachment means for a nail attachment means in a cited patent. Where would the novelty/non-obviousness be other than the creative approach used to form claim language and structure? The current claim language is broad and while it avoids the previously cited art in the prior office action, there is still a need to show criticality for the claimed features in order to avoid the claimed features from being merely design choices.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Chambers
Examiner
Art Unit 3711

January 18, 2006



EUGENE KIM
SUPERVISORY PATENT EXAMINER